



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/282,764      | 03/31/1999  | JAY PONTE            | GTE-99-808          | 9068             |

26161 7590 02/26/2003

FISH & RICHARDSON PC  
225 FRANKLIN ST  
BOSTON, MA 02110

EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 02/26/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/282,764

Applicant(s)

PONTE ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed with an amendment on 8 January 2003 have been fully considered but they are not persuasive. The arguments are discussed at para. 5, 6 and 9 below.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 6-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kramer et al.
4. Kramer et al teaches (independent claims 6, 15 and 24) a method, apparatus and computer program product for targeting/displaying advertisements, the method comprising:  
associating at least one category (e.g., *infant/preschool*) with documents (*candidate illuminations*) that may be retrieved, said category including at least one term (col. 33 lines 8-13); associating at least one supercategory (e.g., *children*) with multiple categories by mapping the multiple categories to the at least one supercategory (col. 32 lines 34-38); associating an advertisement (*content 1408*) with at least one of said supercategories (col. 32 lines 58-60 and 66-67); determining at least one term (one element of *attribute vector 808*) associated with a data query (query of *database 804*, col. 20 line 61 to col. 21 line 8); determining a first of said at least one supercategory based on at least one term of said data query and said multiple categories of the at least one supercategory (col. 32 lines 58-59 and lines cited above); and displaying an advertisement (*content 1408* in Fig. 14) associated with said first supercategory.

Art Unit: 3622

5. Applicant argues (p. 4 bottom para.) that “the attributes/categories of Kramer are not associated with documents”. However, from para. 4 above, the reference teaches associating at least one category (e.g., *infant/preschool*) with documents (*candidate illuminations*, col. 33 lines 8-13).
6. Applicant argues (p. 5 second para.) that the reference does not teach “determining a first of said at least one supercategory based on at least one term of said data query and said multiple categories”. The reference example supercategory is “children” (col. 32 line 35). It is determined by determining least one term, which is to say one element of *attribute vector 808*, associated with a data query (query of *database 804*, col. 20 line 61 to col. 21 line 8). The attributes are, for example, those given at col. 32 lines 36-38. Those attributes are also “multiple categories”, and they determine the supercategory “children”.
7. Kramer et al also teaches at the citations given above claims 8 and 17, where *attribute vector 808* contains multiple terms, and claims 9 and 18.
8. Kramer et al also teaches: claims 7, 16 and 25 (col. 32 lines 47-52 and col. 21 lines 32-34), and also claims 10 and 19, because ranking the supercategories reads on ranking said documents; claims 11 and 20 (col. 14 line 36-39); claims 12 and 21 (col. 6 lines 8-16); claims 13 and 22, where **602(F)** in Fig. 6 is a dedicated ad server (col. 18 lines 18-20) and the *ordered sequence of illuminations* (col. 31 lines 3-5) reads on banner ads, and an example banner ad term list is taught at col. 33 lines 8-13. Claims 14 and 23 are taught inherently since each element of a banner ad term list is at least a title, which reads on “additional data”, of one of said documents (*illuminations*) associated with each said element.
9. Applicant argues (p. 6, beginning at the second para.) that the rejection of claims 7, 10, 16 and 19 is in error. The crux of the argument appears to be a statement near the end of the second paragraph: “the illumination candidates discussed by Kramer are not equivalent to the supercategories”. This statement is not correct. The reference equates illuminations to supercategories, so a ranking of the former is a ranking of the latter, and vice versa. Note, at col. 32 lines 50-52, the reference teaches that the purpose of the illumination sorting is to “determine which categories are most relevant to the consumer”, where “categories” means “aggregate attribute” (at col. 32 line 35), which reads on the instant invention’s “supercategories”. (Note that the supercategory “children” is taught at both lines 50 and lines 35 of col. 32.) Both the reference and instant inventions have the same purpose and

Art Unit: 3622

same mechanism for achieving that purpose. The reference wording speaks of ranking illuminations, not ranking aggregate attributes/supercategories, but that is not a material distinction.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
11. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
13. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
14. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on

Art Unit: 3622

applicant to demonstrate this requirement, preferably in no more than 25 words.

Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

15. Applicant may have after final arguments considered and amendments entered by filing a CPA or RCE as appropriate. It is the examiner's practice to search the specification of CPA/RCE filings for allowable matter. However, unless indicated in this or a previous Office action, examiner cannot give assurances that filing a CPA or RCE will result in an indication of allowable matter.
16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne  
Examiner  
Art Unit 3622

22 February 2003